

Appl. No. 09/854,421  
Response dated September 10, 2004  
Reply to Office action of March 10, 2004

## REMARKS

Reconsideration is respectfully requested. Claims 1-11 are present in the application. No amendments are made herein. A notice of appeal is submitted concurrently herewith.

The Examiner has made a final rejection stating the argument presented is moot based on the Examiner's new ground(s) of rejection. However, the applicant respectfully disagrees that the ground of rejection is a new ground at all as the reference applied in the current action, U.S. Patent 5,099,492 to Zajdmam et al., is the U.S. patent equivalent of the Japanese reference cited in the Examiner's previous action, i.e., JP 03-062579. The applicant traversed the Examiner's previous rejection and presented an argument thereto. If the Examiner is repeating the rejection the applicant would expect the Examiner to take note of the applicant's argument and to answer the substance of it. If the Examiner intends that the argument presented is unpersuasive, then the applicant would expect the Examiner to indicate why. If the Examiner does not find the case allowable, the applicant respectfully requests the Examiner's help in developing a clear issue between the applicant and the Examiner to ready the case for appeal, and indeed, to help applicant determine the advisability of appeal.

The applicant argued, among other things, in the previous response to office action that the reference does not show an

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unobstructed path for light to travel. Zajdman's obstructed path is seen just as easily in the U.S. patent equivalent as it is seen in the Japanese language document. However, the applicant has no way of knowing if the Examiner has referred to the Figure 2 in JP 03-062579 (which is the same as Fig. 4 in U.S. Patent 5,099,492), as requested by the applicant, as the Examiner has not addressed Zajdman's obstruction to the light path.

The applicant would prefer to avoid appeal, and respectfully requests the Examiner reconsider the rejections and allow the case. The applicant respectfully urges the Examiner to review applicant's previously presented argument and to consider the following.

The applicant traverses. The Examiner has rejected claim 1, 3, 5, 9 and 10 under 35 U.S.C. §102(a) as allegedly being anticipated by Zajdman et al. U.S. Patent 5,099,492. Claims 1 and 9 include the limitation "without the need for spacers disposed between the electrodes". Referring now to Fig. 4 of Zajdman et al. of U.S. 5,099,492 there are clearly spacers between the electrodes 1 and 2. Zajdman et al. identifies them as "insulating ring shaped centering members 12 and 13", see col. 3 lines 38-39. Clearly the Zajdman reference does not anticipate claims 1 or 9 or claims 3, 5 and 10 which depend therefrom.

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The Examiner has rejected claim 2, 4, 6-8 and 11 under 35 U.S.C. §103(a) as being "anticipated by" (the applicant believes the Examiner means "unpatentable over" or "made obvious by") Zajdman et al. U.S. Patent 5,099,492. Regarding claim 2, applicant includes the limitation "wherein the two cylindrical electrodes are made from ferromagnetic material that is magnetized to form two or more cylindrical permanent magnetic poles . . . so that the inner and outer cylindrical magnets repel one another". The Examiner argues "It has been held that omission of an element and its function in a combination where the remaining elements perform the same, or where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art." Applicant's invention as claimed in claim 2, using permanent magnetic poles, is very different in structure and approach than Zajdman's device. Zajdman's design is similar to the art of pipe coupling which joins pipes by using annular flanges that extend radially from a central axis of the pipes to be joined. The flanges are held parallel and adjacent to each other and secured by any suitable means. Often the annular flanges are separated by a gasket or such much like Zajdman's insulating rings 3, 13. Zajdman's outer electrode 1 has annular flanges at both ends. Zajdman's inner electrode 2 has an annular flange at the right side of Fig. 4 arranged parallel and to adjacent to one annular flange of the outer electrode 1. The

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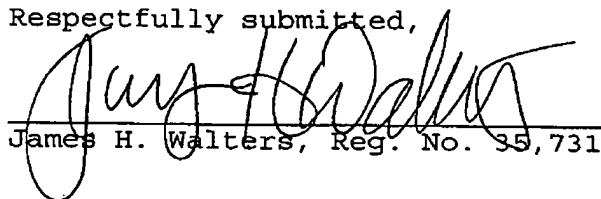
insulating ring 3 extends over each flange to hold them in place. The Examiner's application of In re Karlson, 136 USPQ 184 and In re Aller, 105 USPQ 233 is inappropriate in this case. The differences between applicant's invention as claimed in claim 2 and the reference can not be characterized as mere omission of an element. Claim 11 recites "the inner cylindrical electrodes extend at an upper end thereof into the inner circumferential surface of the ring-shaped trick mirror". Zajdman teaches an annular flat feedback mirror beyond the ends of both electrodes. Claim 11 is clearly patentably distinct from Zajdman. Claims 4 and 6-8 depend from claims believed allowable.

The applicant respectfully requests the Examiner reconsider the rejections and allow the case.

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In light of the above noted remarks, this application is believed in condition for allowance and notice thereof is respectfully solicited. The Examiner is asked to contact applicant's attorney at 503-224-0115 if there are any questions.

Respectfully submitted,

  
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